

REMARKS

Claims 9 to 12 are added, and therefore claims 1 and 9 to 12 are currently pending.

Reconsideration of the application is respectfully requested based on the following remarks.

The Applicants respectfully note that various papers by the Office incorrectly state the title of the present application as being "Method for the secure checking of a memory region of a microcontroller in a control device and control device with a protected microcontroller." However, not only is the second "device" in this incorrect title misspelled as "devide," this is an incorrect title. Correspondence to date from the Applicant has correctly indicated the title of the present application to be "METHOD FOR RELIABLY VERIFYING A MEMORY AREA OF A MICROCONTROLLER IN A CONTROL UNIT AND CONTROL UNIT HAVING A PROTECTED MICROCONTROLLER." Therefore, the Applicants respectfully request that the Office correct their records with regards to the title of the present application. Applicants are filing a formal Notice to Correct the Filing Receipt.

With respect to paragraph 3 of the Office Action, claim 1 was rejected under 35 U.S.C. § 102(b) as anticipated by Fruehling et al., U.S. Patent No. 6,625,688 (hereinafter the "Fruehling" reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17

U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Moreover, the Applicants respectfully request that future Office Actions provide an explanation for the rejections, as required by the Office. The substance of the rejections included in the Office Action on page 3 does not explain the nature of the Office Action's rejections, including how the present application corresponds to the "Fruehling" reference. Instead, the Office Action merely recites the rejected claim language and then conclusorily asserts that the entire "Fruehling" reference corresponds to the claim language. The Applicants respectfully note that the MPEP, in section 706, states the *"goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity."* Furthermore, the MPEP, in section 707.05, also states *"[d]uring the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. When such prior art is cited, its pertinence should be explained."* Moreover, the MPEP, section 707, states *"When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included."*

Claim 1 is directed to a method for *"controlling a microcontroller in a control unit in a motor vehicle having a processor core containing at least one read-only memory area, and at least one rewritable memory area, at least one control program that is intended to be processed by the processor core being stored in the rewritable memory area."* As presented, claim 1 includes the features of *"storing a verification program in a write-once memory area of the rewritable memory area."*

The "Fruehling" reference does not identically disclose (or even suggest) at least the above-identified claim features. Specifically, the "Fruehling" reference does not disclose (or even suggest) at least the claim feature of *"storing a verification program in a write-once memory area of the rewritable memory area."* As explained above, the Office Action does not identify any portion of the "Fruehling" reference that the Office Action regards as the

write-once memory. Indeed, the Applicants respectfully submit that the “Fruehling” reference does not identically disclose (or even suggest) a write-once memory. Instead, the “Fruehling” reference only states: *“Microcontroller unit 10 may also have a flash/ROM memory 36, an EEPROM memory 38, or a RAM memory 40 coupled to bus 12. Each of the types of memories has various numbers of registers that are addressed. The various types of memories associated with bus 12 will vary depending on the application for microcontroller unit 10”* (col. 8, lines 3-8). However, stating that the microcontroller unit may have a flash/ROM memory, an EEPROM memory, or a RAM memory does not identically disclose (or even suggest) a write-once memory. Thus, because the “Fruehling” reference does not identically disclose (or even suggest) a write-once memory, the “Fruehling” reference necessarily also cannot identically disclose (or even suggest) the claim feature of *“storing a verification program in a write-once memory area of the rewritable memory area.”*

Further regarding the claim feature of *“storing a verification program in a write-once memory area of the rewritable memory area,”* the Applicants briefly note some of the important benefits of the presently claimed subject matter are as follows. For example, as described in the present specification, *“[t]he method according to the present invention offers a number of advantages over known methods. For example, only very low additional costs, if any, arise for the controller chip, since only minimum additional work is required. Furthermore, the verification program may be individually adapted to needs or requirements since this code sequence is not contained in the ROM mask. It may also, therefore, be kept customer-specific. Moreover, the manufacturer of the controller is able to offer that functionality to other customers also.”*

Therefore, the features of claim 1, as presented, including the features identified above, are not identically disclosed (or even suggested) by the “Fruehling” reference. Accordingly, claim 1, as presented, is allowable. It is therefore respectfully requested the anticipation rejection of claim 1 be withdrawn.

With respect to newly added claims 9 to 12, these claims do not add any new matter and are supported by the present application. These claims depend from claim 1, and are therefore allowable at least for the same reasons as claim 1.

Accordingly, claims 1 and 9 to 12 are allowable.

CONCLUSION

Applicants respectfully submit that all pending claims of the present application are allowable. It is therefore respectfully requested that the rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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